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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,603	04/28/2000	Mark R. Sento	SSO-10002/29	4629

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,603

Applicant(s)

SENDO ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

STATUS

Claims 1 has been canceled

Claims 2-9 remain pending and are again presented for examination

Claims 18-22 have been added.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Response to Arguments

The applicant's arguments filed on April 28, 2003 have been fully considered but are not persuasive.

As per claim 18,

The Applicant states that the Rowney et al. reference does not teach a method of securely transferring data having a corresponding equivalent monetary value in a communications system wherein the method includes utilizing a recordable medium being encoded with at least one non reusable token being equivalent to a monetary value as a proxy for sensitive data commonly transferred over a network.

The Examiner responds that this feature is disclosed by the newly discovered reference to Briscoe (US Patent 6,341,273). Briscoe discloses a system wherein an electronic coin stick is generated using a random has value (i.e. a non reusable token being equivalent to a monetary value)

The Examiner further states that the method disclosed by Briscoe does not associate any sensitive or personal customer data with the cash proxy data token since Briscoe generates the value from a random number.

The Applicant states that the Rowney et al. reference does not teach a method of securely transferring data over a communications network wherein the method utilizes a first set of data that includes at least one non-reusable token being the equivalent to a monetary value for facilitating business transactions between a consumer and a merchant.

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The Examiner responds that this feature is disclosed by the to Briscoe. The hashed value of the coins stick disclosed by Briscoe is a non-reusable token being the equivalent to a monetary value.

The Applicant states that the claims of the present invention are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states that both of these references deal with the same generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being anticipated by Rowney et al. (US Patent 5,996,076)

As per claim 4,

Rowney et al. ('076) discloses a system for conducting secure transactions over a network, comprising:

a recordable media controlled by a consumer, wherein said recordable media comprises data read and transmitted over the network by a computer device;(Figure 1A)

a second device having a transaction data set, wherein the second device receives the data from the recordable media and forwards the data and a portion of the transaction data over the network;(Figure 2)

an authentication device, wherein said authentication device verifies the data originating from the recordable media and the portion of the transaction data set originating from the second device, and forwards via the network an authorization message to the second device for completion of the secure payment transaction.(Figure 3 -- the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

As per claim 5,

Rowney et al. ('076) discloses the system of claim 4, wherein the data is encrypted. (Figure 4)

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As per claim 6,
Rowney et al. ('076) discloses the system of claim 4,
wherein the transaction data set is encrypted.(Figure 10)

As per claim 7,
Rowney et al. ('076) discloses the system of claim 4,
wherein the authorization message is encrypted.(Figure 4)

As per claim 8,
Rowney et al. ('076) discloses the system of claim 4,
Official Notice is taken that "the recordable media comprises a self contained, portable unit" is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the secure device comprises a self contained, portable unit because portable secure self contained devices are inexpensive and easily obtained by consumers. The examiner notes that the limitations of this claim are met by many PDA's and handheld devices currently available on the market.

Claims 2,3,9,18-22 are rejected under 35 U.S.C. 103(a) as being anticipated by Rowney et al. (US Patent 5,996,076) in view of Briscoe (US Patent 6,341,273)

As per claim 2,
Rowney et al. ('076) discloses a method as recited in claim 18,
wherein the recordable media is a medium capable of storing data for retrieval by a disk drive. (Figure 1A)

As per claim 3,
Rowney et al. ('076) discloses a method as recited in claim 2,
whereby the communications system is the Internet. (Column 4, lines 52-54)

As per claim 9,
Rowney et al. ('076) discloses a recordable media according to claim 18,
Official Notice is taken that "comprising dimensions approximately the size of a credit card" is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the device would comprise the dimensions approximately the size of a credit card because this allows the consumer the convenience of carrying the device in a wallet or a purse . The examiner notes that the limitations of this claim are met by many smart cards.

As per claim 18,
Rowney et al. ('076) discloses a method of securely transferring data having a corresponding equivalent monetary value in a communications system including a first device having a first set of data encoded thereon, a second device having a second set of data thereon,

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and a third device having a third set of data encoded thereon, and a fourth device having a fourth set of data thereon, the method comprising the steps of:

Sending a request to the second device to perform a transaction via user interface (Column 14, lines 55-61).

transmitting the first set of data from the recordable media to the third device;(Figure 3—the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

transmitting a portion of the third set data to the fourth device. (Column 15, lines 45-53)

transmitting an instruction from the third device to the second device whereby the second device completes the transaction request according to a predetermined process. (Column 15, lines 45-53)

Official Notice is taken that “comparing the first set of data to the third set of data for verification purposes” is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the first set of data to the third set of data for verification purposes because this prevents fraud. The examiner notes that any modern POS type transaction system verifies the consumers account data., this Argument also applies to the feature of comparing the third data set to the fourth data set.

Rowney et al. ('076) does not specifically disclose retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value. Briscoe. ('273) discloses retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value, (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to create an anonymous form of electronic money.

As per claim 19,

Rowney et al. ('076) discloses a method of securely transferring data having a corresponding equivalent monetary value in a communications system including a first device having a first set of data encoded thereon, a second device having a second set of data thereon, and a third device having a third set of data encoded thereon, and a fourth device having a fourth set of data thereon, the method comprising the steps of:

Sending a request to the second device to perform a transaction via user interface (Column 14, lines 55-61).

transmitting the first set of data from the recordable media to the third device;(Figure 3—the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

transmitting the first portion of the third set of data from the third device to the user interface;(Figure 3)

transmitting an instruction from the third device to the second device. (Column 15, lines 45-53)

transmitting a portion of the third set data to the fourth device for authentication purposes. (Column 15, lines 45-53)

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit a second portion of the third set of data from the third device to the fourth device, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

transmitting an instruction from the fourth device to the second device whereby the second device completes the transaction request according to a predetermined process. (Column 15, lines 45-53)

Official Notice is taken that “comparing the first set of data to the third set of data for verification purposes” is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the first set of data to the third set of data for verification purposes because this prevents fraud. The examiner notes that any modern POS type transaction system verifies the consumers account data., this Argument also applies to the feature of comparing the third data set to the fourth data set.

Rowney et al. ('076) does not specifically disclose retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value. Briscoe. ('273) discloses retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value, (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to create an anonymous form of electronic money.

As per claim 20,

Rowney et al. ('076) discloses a method as recited in claim 18,

Official Notice is taken that “the recordable media optically recordable” is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the recordable media optically recordable because recordable media (CDR) is inexpensive to use.

As per claim 21,

Rowney et al. ('076) discloses a method as recited in claim 18,
wherein the user interface is a personal computer. (Figure 1A)

As per claim 22,

Rowney et al. ('076) discloses a method as recited in claim 18,

Rowney et al. ('076) does not specifically disclose invalidating at least one non-reusable token from the recordable media after verification. Briscoe. ('273) discloses invalidating at least one non-reusable token from the recordable media after verification, (Column 6, lines 31-46) it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to prevent fraud.

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Conclusion

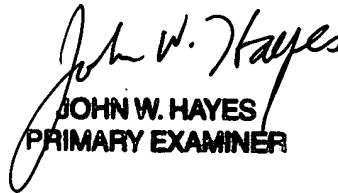
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

July 10, 2003


JOHN W. HAYES
PRIMARY EXAMINER